

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-16 remain pending, claims 1 and 13 being independent claims.

In this Reply, Applicant has amended claims 1, 2, 3, 5, 13, 14 and 16. Furthermore, Applicant has amended the Abstract and editorial amended the specification to address the objection set forth on page 2 of the Office Action.

In view of the amended Abstract and the editorial amendment to the specification, Applicant respectfully requests that the objection to the Abstract and specification be withdrawn.

Drawings

The formal drawings filed with the present application on January 25, 2002, appear to be approved. The Examiner is courteously requested to provide a Notice of Draftsperson's Patent Drawing Review (Form PTO-948) with the next official communication to confirm approval of the formal drawings filed with the present application by the Official Draftsperson.

Claim for Priority

The Examiner has acknowledged Applicant's claim for priority and receipt of the certified copy of the priority document. No further action is required at this time.

Claim Status

35 U.S.C. §102(e) Rejection

Claims 1-12 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0035495 A1 to Spira et al. This rejection is traversed.

The present invention is directed to a system and method for inspecting thermal equipment at a facility site under contract therefore and reporting on the operating condition of the inspected equipment. The present invention provides for periodic automated inspection of the thermal equipment and for generating, maintaining, and delivering periodic automated records and reports thereon. The appearance of abnormalities in the thermal equipment are also identified and recorded. As a result, the burden on staff associated with monitoring the

equipment and preparing regular (e.g., daily, weekly, monthly) reports on operating conditions and the attendant human error in observation and recordkeeping are substantially reduced. An operating-state information collecting device is connected to a modem, which communicates with an information processing device of a management center. An output device is connected to the operating-state information collecting device, and a storage device is connected to the information processing device at the management center.

In contrast thereto, Spira et al. is directed to a generalized method of providing maintenance services for a number of different types of programs. Allegedly, the method of Spira et al. can be used in a variety of manufacturing environments.

In paragraph [0049], Spira et al. specifically states that his invention uses the "customer's own operating personnel to carry out all or part of the first line including inspections, lubrication and other activities as part of a total plant management based philosophy." Accordingly, Spira et al. requires the same number or additional personnel to carry out a

particular maintenance program, whereas in the system and method of the present claimed invention, human labor is minimized.

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant respectfully submits that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited reference, Spira et al., fails to teach or suggest each and every feature as set forth in the claimed invention.

For example, claim 1 recites a method for inspecting thermal equipment, comprising the steps of ". . . making the information

processing device execute creation of report data for use of inspection recording related to an inspection of the thermal equipment as well as delivery of the created report data to the facility site; and outputting from an output device a report based on the report data delivered from the information processing device at the facility site." Spira et al does not perform either of these steps, because Spira et al is directed to evaluating customer's needs and then recommending services.

The Examiner's attention is directed, initially, to paragraph [0008] of Spira et al which states "The customer needs are evaluated and the customer is offered the services as modules selected from a menu." In other words, according to paragraph [0036], Spira et al does not provide reactive maintenance to the facility "when there is a breakdown," Spira et al provides pro-active approach "with preventive schedules and a high degree of planning and scheduling." The Examiner's assertion that Spira et al, in paragraph [0063], outputs from an outputting device delivered from the facility, is incorrect. Instead, Spira et al states that all the information is carefully planned off site and then delivers to the customer, (see paragraph [0063]).

In single broad sentences, the Examiner improperly groups and rejects claims 2 and 6, claims 3, 5, 7, 9, 11 and 12, as well as claims 4 and 10.

With respect to claims 2 and 6, the Office Action states that Spira et al teaches "the information related to operation state is fetched into the information-processing device at a specified time point." The Examiner cites to paragraph [0084], [0103] and [0157]. A careful study of these cited paragraphs notes that the Examiner inadvertently misread Spira et al. Paragraph [0084] relates to services provide to the customer, paragraph [0103] is directed logistic services of supplying parts, and paragraph [0157] is related to preplanned maintenance time schedules. None of these paragraphs in Spira et al teach "fetching the information related to the operating state of the thermal equipment occurs at a specified time point," as recited in amended claim 2, or "at a specified time interval," as recited in claim 6.

Amended claim 3 particularly points out and distinctly claims three additional steps of the method for inspecting thermal equipment as does claim 5 which is dependent on claim 4.

Claims 9, 11 and 12 each recite that "the report data is stored in a data storage device each time of creation of the report data" amongst other features. However, claim 9 is dependent on claim 8, claim 11 is dependent on claim 10, and claim 12 is dependent on claim 1. Claims 4 and 10 both recite "abnormality information on the thermal equipment is fetched into the information processing device, and the fetched abnormality information is included in the report data." Spira et al uses previous maintenance strategies to provide the customer with twenty-two preplanned performance indicators. There is no fetching of abnormality information as recited in the claims.

Claim 8 has not been addressed in the Office Action. Thus, the Examiner is requested to indicate the claim as allowable over Spira et al.

It appears that the Examiner is relying on the concept of probability or possibility "that the reference includes the features claimed". But, a rejection under 35 U.S.C. § 102 cannot be based on this premise. That is, it is submitted that it is not inherent in the reference that the features claimed are shown. See *Continental Can Co., USA, Inc. v. Monsanto Co.*,

20 USPQ2d. 1746 (Fed. Cir. 1991) wherein the court stated as follows:

Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient
. . . .

Also, in the unlikely event that the Examiner is to continue a rejection under 35 U.S.C. § 102, the Examiner is requested to specifically point out where the features are found in the reference. See *Ex parte Levy*, 17 USPQ2d. 1461, 1462 (BPAI 1990) (also cited in the MPEP) wherein the Board stated as follows:

Moreover, it is incumbent upon the Examiner to identify where each and every facet of the claimed invention is disclosed in the applied reference.

With respect to the dependent claims rejected under 35 U.S.C. § 102 (claims 2-12), these claims are considered patentable at least for the same reasons as the base claim, as well as those discussed. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejection of claims 1-12 under 35 U.S.C. § 102(e) based on *Spira et al.*

35 U.S.C. §103(a) Rejection

Claims 13-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Spira et al. in view of U.S. Patent No. 6,308,328 to Bowcutt et al. This rejection is traversed.

Independent claim 13 also recites features not found in Spira et al. The claim states "a system for substantially reducing personnel and human error during required periodic inspections of thermal equipment. . ." Spira et al actually seeks to utilize the customer's personnel, not reducing the use of personnel, as in the present invention. Additionally, the claim recites "an operating-state information collecting device, provided at the facility site, for collecting information related to operating operating states of the thermal equipment;" and "an information processing device provided at the management center and for fetching the information related to the operating states of the thermal equipment via the communication line and for executing a creation of report data for inspection recording, the inspection recording related to an inspection of the thermal equipment as well as delivery of the created report data to the facility site. . .".

Accordingly, it is requested that the Examiner provide some evidence that Spira et al, as the primary reference, teaches or suggests at least the following features of claim 13 which include (1) "a system for substantially reducing personnel and human error during required periodic inspections of thermal equipment. . ."; (2) "an operating-state information collecting device, provided at the facility site, for collecting information related to operating states of the thermal equipment"; or (3) "an information processing device provided at the management center and for fetching the information related to the .operating states of the thermal equipment via the communication line and for executing a creation of report data for inspection recording, the inspection recording related to an inspection of the thermal equipment as well as delivery of the created report data to the facility site. . .". It is submitted that these features are not found or suggest in Spira et al, because Spira et al directed to evaluating customer's needs and then recommending services.

For example, Spira et al states that "[t]he customer needs are evaluated and the customer is offered the services as modules selected from a menu," (see paragraph [0008]). According to

paragraph [0036], Spira et al does not provide reactive maintenance to the facility "when there is a breakdown," Spira et al provides pro-active approach "with preventive schedules and a high degree of planning and scheduling." In fact, contrary to the Examiner's summary of Spira et al, paragraph [0063] is directed to the carefully planning of these schedules, off site and then the preplanned schedule is delivered to the customer.

Motivation to Combine

Applicant submits that insufficient evidence of motivation is presented such that one of ordinary skill would have been motivated to combine the teachings of Spira et al. and Bowcutt et al. Applicant directs the Examiner's attention to two recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999) and *In re Kotzab*, 55 USPQ2d 1313 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103(a).

In the Office Action, the Examiner states that Spira et al does not disclose "a facility-side modem interposed between the operating-state information collecting device and the communication

line; and a center-side modem interposed between the information processing device and the communication line." Applicant agrees with the Examiner that Spira et al also does not disclose these features recited in independent claim 13. However, it is submitted that Spira et al does not disclose the other noted features of claim 13, and it is submitted that this claim is patentable thereover.

Bowcutt et al. appears to be cited by the Examiner for teaching a facility-side modem interposed between an operating-state information collecting device, and a communication line or a center-side modem interposed between the information processing device and the communication line.

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to combine the modem pool 135, RF modem 106, and communication manager 102 of Bowcutt et al. with the method of providing maintenance services of Spira et al. to provide a cable data delivery system provided over an existing cable television distribution network. But why would one destroy the preventive maintenance scheduler of Spira et al which is allegedly capable of delivering professional maintenance services throughout the world, (see paragraph [0012])? In actuality, Spira et al is a fitness plan for long

term use. One of ordinary skill in the art, would either fully implement the method of Spira et al or not use it. Accordingly, this combination is traversed, because it is improper and Spira et al must be withdrawn as a primary reference.

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. The motivation, suggestion or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill art, or in some cases, the nature of the problem to be solved. See *Dembiczak* 50 USPQ at 1614 (Fed.Cir. 1999). In *Kotzab*, the CAFC held that even though various elements of the claimed invention were present (in two separate embodiments of the same prior art reference), there was no motivation to combine the elements from the separate embodiments, based on the teachings in the prior art.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See *Dembiczak* 50 USPQ2d at 1617. Surely, the Examiner knows

that broad conclusory statements standing alone are not "evidence". Therefore, there is no evidence of motivation from Spira et al and the Examiner is requested to withdraw the rejection.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and such allowance is respectfully solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Daniel K. Dorsey (Reg. No. 32,520), to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to the provisions of 37 CFR 1.17 and 1.136(a), Applicant respectfully petitions for a one (1) month extension of time for filing a response in connection with the present application. The required fee of \$110.00 is attached hereto.

Group Art Unit 2863
Appln. No. 10/055,341
Reply to Office Action of June 17, 2003
Docket No. 1921-0138P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s): Abstract of the Disclosure